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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,498	09/15/2003	Naoyuki Egusa	117174	7406

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EXAMINER	
DOTE, JANIS L	

ART UNIT	PAPER NUMBER
1756	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/661,498	EGUSA ET AL.	
	Examiner	Art Unit	
	Janis L. Dote	1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) *14-19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-19* are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 September 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/15/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Applicants' election without traverse of the invention of Group I, claims 1-13, in the reply filed on Dec. 16, 2005, is acknowledged.

2. Claims 14-19 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Dec. 16, 2005.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

In Fig. 2, the reference character **46**.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The abstract of the disclosure is objected to because it is not limited to a single paragraph. Correction is required. See MPEP § 608.01(b).

Applicants are reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The disclosure is objected to because of the following informalities:

(1) There are a number of misspellings throughout the specification, e.g., "sequred" at page 15, line 3. This example is not exhaustive. Applicants should review the entire specification to correct the misspellings.

(2) The use of trademarks, e.g., "Docutech" [sic: DOCUTECH] at page 30, line 8, has been noted in this application. The trademarks should be capitalized wherever they appear and be accompanied by the generic terminology. This example is not exhaustive. Applicants should review the entire specification for compliance.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required.

6. The examiner notes that the instant specification at page 11, lines 15-16, defines the term "transparent" recited in the instant claims as "the property of transmitting a light in the visible region to a certain extent."

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US 5,327,201 (Coleman).

Coleman teaches a method of making an imaged medium comprising the steps of: (1) laminating a plurality of color toner image layers on a surface of a transparent substrate to form a full color image; (2) fixing the plurality of toner layers; and (3) laminating the fixed toner layers with a laminating film. Col. 6, lines 52-68; col. 10, line 1, to col. 11, line 20; col. 11, lines 35-30; and col. 13, line 52, to col. 14, line 40; and Figs. 4 and 5.

9. US 2003/0043108 A1 (Iwase) was published prior to the instant application's filing date of Sep. 15, 2003. Iwase is available as prior art under 35 U.S.C. 102(a) and 102(e).

10. Claims 1-9 and 11-13 are rejected under 35 U.S.C. 102(a) as being anticipated by Iwase.

Claims 1-9 and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwase.

Iwase teaches a method of making a display panel, comprising the steps of: (1) laminating a plurality of toner image layers on a surface of a transparent substrate **10** and fixing by heat the plural toner layers to the surface of the transparent substrate **10** by electrophotography; (2) heat-treating the fixed toner layers at a temperature where the melt viscosity of the toners is within a prescribed range for about 10 minutes to one hour to fill pinholes formed in the toner image layers; and (4) laminating the heat-treated toner layers of step (3) with a transparent film **40**. Paragraphs 0054, 0086, 0087, 0093-0096; Fig. 1; and example 4 in paragraph 0124. The plurality of toner layers includes a black toner layer **b** that is printed, i.e., developed, twice with a black toner; and a continuous white toner layer **a** that is formed as the uppermost toner layer. Fig. 1 and paragraphs 0095-0096. The plurality of toner layers meets the toner layer limitations recited in instant claims 2, 3, 7, and 8. The toner layers can be formed with a developer comprising a toner and a carrier where the

toner is presence in an amount of 2 to 12 wt% based on the weight of the developer, which meets the developer limitations recited in instant claims 4 an 9. Paragraph 0077. Iwase teaches that the temperature of the heat-treating step (3), which depends on the prescribed melt viscosity of the toners used, can be 100°C or 110°C and that the heat-treatment can be performed in a constant temperature bath. Example 4 and examples 6-9 in Table 4 at page 14 and in paragraph 0243. The heat-treating temperatures of 100 and 110°C are within the temperature ranges recited in instant claims 5 and 11. The constant temperature bath heating meets the non-contact fixing state recited in instant claim 13.

Iwase does not state that the heat-treatment step (3) is a fixing step as recited in the instant claims. However, as discussed above the Iwase heat-treatment step meets the fixing limitations recited in instant clams 5 and 11-13. Thus, it is reasonable to presume that the Iwase heat-treatment step has the characteristics of a fixing step as recited in the instant claims. The burden is on applicants to prove otherwise. In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy

reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1, 5, 6, 10, 11, and 13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,985,691 B2 (Kodera).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter recited in the Kodera claims renders obvious the methods for producing an image recorded medium recited in the instant claims.

Kodera claim 1 recites an image forming method comprising the steps of: (1) laminating a plurality of toner layers on a surface of a transparent substrate electrophotographically; (2) fixing the plural toner layers to the surface of the transparent substrate in a primary fixing step; and (3) fixing the primary fixed plural toner layers in a secondary fixing step. The steps recited in claim 1 meet the fixing steps recited in instant claim 1 and 6. Kodera claims 2 and 3, which depend from claim 1, recite that the secondary fixing step is carried out in a non-contact manner and that the secondary fixing step is carried out at 100 to 140°C, respectively. The process limitations recited in claims 2 and 3 meet the fixing step limitations recited in instant claims 11 and 13, respectively. The fixing temperature of 100 to 140°C meets the fixing temperature T1 recited in instant claim 5. Kodera claim 7, which depends on claim 1, recites that the primary fixing step is carried out at a fixing temperature of 100 to 145°C, which overlaps the range of 100 to 140°C recited instant claim 10. Kodera claim 8, which depends on claim 1, recites an image-recorded medium that is formed by forming the fixed toner images as recited in claim 1 and laminating the fixed image with a transparent laminate film. The lamination step in claim 8 meets the lamination step recited in instant claims 1 and 6.

It would have been obvious for a person having ordinary skill, in view of the subject matter recited in the Kodera claims, to incorporate the laminating step recited in Kodera claim 8 in the image forming method recited in the claims of Kodera. That person would have had a reasonable expectation of successfully obtaining an image forming method that provides a laminated permanent image-recorded medium.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (571) 273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD
Feb. 18, 2006

Janis Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1500 1700